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EXAMINER	
MCCORD, PAUL C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/553,811	CSICSATKA ET AL.	
	Examiner	Art Unit	
	PAUL MCCORD	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-7 rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-5, 8, 10-13, 15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platt (US Patent 6987221), further in view of Heo (US Patent 7046588.)

7. Regarding claims 1, 8, 15

Platt teaches:

A method and system for compiling a playlist of digital audio data files (see Abstract: method of playlist generation) wherein the user may browse the contents of a data storage device and select digital audio files therefrom for playback, preview and/or inclusion in a playlist (Column 4, lines 12-67; Col 6, l. 17-39: a first user input of metadata is entered, a playlist generator 104 in concert with a media analyzer 102 receives the metadata and

selectively culls media files from a media database 106 based on metadata associated with the media files, in the alternate an entire media library could be opened.) A user may determine preference toward a particular digital audio file by playing the file, or in the alternate previewing an time constrained portion or audio clip from each or any one of the selected audio data files (Col 6, l. 60-67: a digital audio file can be played by double clicking on the track or highlighting the track and implementing a play button **460,** a preview of the file can be played following selection of a media file or files by activation of the preview button 440.) While the file is playing and/or in preview a user can add the media file to a playlist by clicking on the add button **450** (Col 6, l. 40-67) thereby allowing a user input to accept files for inclusion in a playlist. The media player itself (Col 7, l. 49-61; Fig 1, 4 media player **108, 480**) operates in concert with connected storage devices **106** and signal processors contained therein, under control of the user interface to respond to user inputs including adding and deleting media from a playlist as well as saving and deleting playlists themselves. The control also operates upon metadata representative of the digital audio data file and stored associatively therewith (Col 4, l. 25-30: meta data is incorporated with the media in the form of an ID3 tag) selectable and storable while a currently playing audio clip is saved to a playlist in response to a user input. (Col 6, l. 40-67: while browsing a media library opened in response to a first user input a second user input can be employed to add that media item (and metadata incorporated in an ID3 tag) to a playlist by depression of the add button 450.)

Platt does not explicitly teach:

A method including **sequentially playing an audio clip from each one of the selected audio data files.**

In a related field of endeavor Heo teaches:

A method and apparatus for reproducing portions of an audio selection or selection comprising **sequentially playing an audio clip from each one of the selected audio data files.** (Col 7, l. 18-57; Figure 8) Highlights or clips from each of a listed plurality of media files are played in sequence until the end of the list is reached.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the sequential highlight or clip playing disclosed by Heo in the Platt method of previewing media files. One would have been motivated to do so for the purpose of aiding in the rapid identification of a track or sequence of tracks in a large media library.

8. Regarding claim 2

Platt does not teach:

The method of claim 1, **wherein each audio clip is taken from a predetermined portion of its associated audio data file that is selectable by the user.**

Heo teaches:

A method and apparatus for reproducing portions of an audio selection or selection comprising **wherein each audio clip is taken from a predetermined portion of its associated audio data file that is selectable by the user.** (Col 4, l. 38-46) Users can designate a desired portion of the audio file to function as a clip or highlight thereby predetermining a portion of data that will be reproduced.

9. Regarding claim 3

Platt teaches:

The method of claim 1, **wherein an associated data tag of the audio data file** can be an ID3 tag containing various user definable metadata (Col 4, l. 24-37)

Platt does not teach:

The method of claim 1, **wherein each audio clip is taken from a portion of its associated audio data file according to an audio clip parameter of an associated data tag of the audio data file.**

Heo teaches:

A method and apparatus for reproducing portions of an audio selection or selection comprising **wherein each audio clip is taken from a portion of its associated audio data file,** (Col 4, l. 38-46)

Heo applied to Platt teaches:

A method of compiling a playlist wherein associated audio data files can contain user definable tag metadata including audio clip parameters related to the reproduction of a predetermined portion of the audio data file (i.e. **according to an audio clip parameter of an associated data tag of the audio data file.**)

It would have been obvious to one of ordinary skill in the art at the time of the invention to include audio clip parameter data within the associated track information or tag metadata of the audio data file as taught by Heo in the playlist method of Platt for the purpose of aiding in the rapid identification of a track or sequence of tracks in a large media library.

10. Regarding claim 4

Platt teaches:

The method of claim 1, **wherein audio clips can be grouped depending on a genre characteristic of the audio data file or other user specifiable metadata characteristics.** (Col 4, l. 15-36)

Platt does not teach:

A method **wherein each audio clip is taken from a portion of its associated audio data file depending on a genre characteristic of the audio data file.**

Heo teaches:

A method and apparatus for reproducing portions of an audio selection or selection wherein a preview or highlight is taken from a portion of the audio data file based on user specifiable metadata characteristics. (Col 4, l. 38-46) Users can designate a desired portion of the audio file to function as a clip or highlight thereby predetermining a portion of data that will be reproduced.

Heo applied to Platt teaches:

A method of compiling a playlist wherein audio files can contain user definable tag metadata including audio clip parameters related to the reproduction of a predetermined portion of the audio data file and genre characteristics related to the mood, tempo, rhythm, etc. of the audio file.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method for including metadata relevant to a user defined preview section of an audio file taught by Heo with a method for sorting audio data files

into playlists based on metadata genre characteristics taught by Platt. One would have been motivated to do so for the purpose of aiding in the rapid identification of a track or sequence of tracks in a large media library.

11. Regarding claim 5

Platt does not teach

The method of claim 1, **wherein each audio clip is played for a predetermined duration selectable by the user.**

Heo teaches:

A method and apparatus for reproducing portions of an audio selection or selection comprising **wherein each audio clip is played for a predetermined duration selectable by the user.** (Col 5, l. 40-60) Users can designate a desired portion of the audio file to function as a clip or highlight thereby predetermining a portion of data that will be reproduced. A highlight start time and a highlight end time constitute highlight duration information denoting the time length or highlight duration. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the encoding of a user predetermined highlight duration in the track information as taught by Heo in the Platt method for the purpose of aiding in the rapid identification of a track or sequence of tracks in a large media library.

12. Regarding claim 8

Platt teaches:

A digital audio data player comprising (Col 4, l. 4-12; Fig 1: system **100** plays media files and playlists)**: a data storage device for storing a plurality of digitally encoded**

audio data files (Col 4, l. 4-36; Fig 1; media database **106** stores a collection of media items)**; a signal processing unit for receiving a selected collection of the stored digitally encoded audio data files** (Col 5, l. 5-15; Fig 1: media player **108** functions as a signal processing unit engaging in suitable functions associated with audibly providing media files to users including decoding and playing audio clips)**, a user input device for accepting user input** (Col 6, l. 17-39; Fig 4: user interface allows user to perform a number of actions)**; and a controller** (Col 7, l. 49-61: media player **480** operates to control volume and other system parameters)**, coupled to the data storage device** (Fig 1 shows media database **106** (data storage) coupled to media player **108** operable as a controller and containing a signal processing unit and user interface)**, wherein the controller allows inclusion of identifying data representative of the stored digitally encoded audio data file associated with a currently playing audio clip to a playlist of digitally encoded audio data files.** (Col 4, l. 34-56: meta data can be entered by a user and thus included within the metadata tag associated with an audio data file; the audio data file is included within an automatically generated playlist)

Platt does not explicitly teach:

A digital audio player comprising **a signal processing unit for decoding an audio clip of each one of the stored digitally encoded audio data files of the selected collection, and playing the decoded audio clip of each one of the stored digitally encoded audio data files;**

a controller, coupled to the data storage device, the signal processing unit, and the user input device, for controlling the operation of the data storage device and the

signal processing unit in response to user input, wherein the controller allows inclusion of identifying data representative of the stored digitally encoded audio data file associated with a currently playing audio clip to a playlist of digitally encoded audio data files.

Heo teaches:

A digital audio player comprising **a signal processing unit for decoding an audio clip of each one of the stored digitally encoded audio data files of the selected collection, and playing the decoded audio clip of each one of the stored digitally encoded audio data files;** (Col 9, l. 28-40; Fig 12: audio output processor **110** in concert with audio decoder **108** functions as a signal processing unit suitably decoding and playing digital media files and/or clips thereof.)

And **a controller** (Col 9, l. 28-40; Fig 12: system controller **102**), **coupled to the data storage device** (Col 9, l 22-27: Fig 12 shows the recording and reproducing apparatus for reproducing digital media files from a recording medium or data storage device **106**), **the signal processing unit** (Fig 12: audio output processor in concert with audio decoder), **and the user input device for controlling the operation of the data storage device and the signal processing unit in response to user input** (Col 9, l. 40-56; Fig 12: user interface **112** receives commands for controlling the recording and reproduction of media files on the data storage device **106** by signal processing unit (audio output processor in concert with audio decoder)), **wherein the controller allows inclusion of identifying data representative of the stored digitally encoded audio data file associated with a currently playing audio clip** (Col 5, l. 40-50: track information including a start point

and duration of an audio clip can be included into metadata recorded into a track information space) **to a playlist of digitally encoded audio data files** (Col 2, l 20-30: highlight or preview portions of audio files are associated with the audio file and linked to a playlist when the audio track is linked to the playlist**.)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a controller and signal processing unit as taught by Heo within the digital audio player of Platt. One would have been motivated to do so for the purpose of aiding in the rapid identification of a track or sequence of tracks in a large media library.

13. Regarding claim 10

Platt does not teach

The digital audio data player of claim 8, **wherein the controller is operative to take each audio clip from a predetermined portion of its associated audio data file that is selectable by the user.**

Heo teaches:

The digital audio data player of claim 8, **wherein the controller is operative to take each audio clip from a predetermined portion of its associated audio data file that is selectable by the user.** (Col 4, l. 38-46; Col 9, l. 28-40; Fig 12) User designates through user interface **112** a desired portion of the audio file to function as a clip or highlight thereby predetermining a portion of data that will be reproduced.

14. Regarding claim 11

Platt teaches:

The digital audio data player of claim 8 **wherein an associated audio data file** can be an ID3 tag containing various user definable metadata (Col 4, l. 24-37)

Platt does not teach:

The digital audio data player of claim 8, **wherein the controller is operative to take each audio clip from a portion of its associated audio data file according to an audio clip parameter of an associated data tag of the audio data file.**

Heo teaches:

The digital audio data player of claim 8, **wherein the controller is operative to take each audio clip from a portion of its associated audio data file according to an audio clip parameter of an associated data tag of the audio data file.** (Col 4, l. 38-46; Col 9, l. 28-40; Fig 12)

Heo applied to Platt teaches:

An audio data player wherein **the controller** (Col 9, l. 28-40; Fig 12: system controller **102**) **is operative to take each audio clip from a portion of its associated audio data file** (Col 4, l. 38-46; Col 9, l. 28-40; Fig 12: controller reproduces highlight portion of the audio data) **according to an audio clip parameter of an associated data tag of the audio data file** (Col 9, l. 30-50: audio data files contain user definable tag metadata including audio clip parameters**.)**

15. Regarding claim 12

Platt teaches:

The digital audio data player of claim 8, **wherein the controller can group audio clips depending on a genre characteristic of the audio data file or other user specifiable metadata characteristics.** (Col 4, l. 15-36)

Platt does not teach:

The digital audio data player of claim 8, **wherein the controller is operative to take each audio clip from a portion of its associated audio data file depending on a genre characteristic of the audio data file.**

Heo teaches:

An apparatus for reproducing portions of an audio selection or selection wherein the controller can be user to preview or highlight a portion of the audio data file based on user specifiable metadata characteristics. (Col 4, l. 38-46) Users can designate a desired portion of the audio file to function as a clip or highlight thereby predetermining a portion of data that will be reproduced.

Heo applied to Platt teaches:

A digital audio player wherein a controller can encode audio files with user definable tag metadata including audio clip parameters related to the reproduction of a predetermined portion of the audio data file and genre characteristics related to the mood, tempo, rhythm, etc. of the audio file.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the player wherein the controller encodes metadata relevant to a user defined preview section of an audio file taught by Heo with a player wherein the controller sorts audio data files into playlists based on metadata genre characteristics

taught by Platt. One would have been motivated to do so for the purpose of aiding in the rapid identification of a track or sequence of tracks in a large media library.

16. Regarding claim 13

Platt does not teach:

The digital audio data player of claim 8, **wherein the controller is operative to play each audio clip for a predetermined duration.**

Heo teaches:

An apparatus for reproducing portions of an audio selection or selection comprising **a controller operative to play each audio clip for a predetermined duration.** (Col 5, l. 40-60) Controller (Fig 12: User interface unit **112)** can designate a desired portion of the audio file to function as a clip or highlight thereby predetermining a portion of data that will be reproduced. A highlight start time and a highlight end time constitute highlight duration information denoting the time length or highlight duration. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the encoding of a user predetermined highlight duration in the track information as taught by Heo in the Platt method for the purpose of aiding in the rapid identification of a track or sequence of tracks in a large media library.

17. Regarding claim 15

Platt teaches:

In a digital audio data player (Col 4, l. 4-12; Fig 1: system **100** plays media files and playlists)**: a method of compiling a playlist of digital audio data files** (see Abstract: method of playlist generation) **comprising the steps of: allowing user selection of a**

plurality of audio data files (Column 4, lines 12-67; Col 6, l. 17-39: a first user input of metadata is entered, a playlist generator **104** in concert with a media analyzer **102** receives the metadata and selectively culls media files from a media database **106** based on metadata associated with the media files, in the alternate an entire media library could be opened)**; and during playing of an audio clip, populating a playlist with identifying data representative of the stored audio data file** (Col 4, l. 25-30: meta data is incorporated with the media in the form of an ID3 tag) **associated with the currently playing audio clip in response to user input** (Col 6, l. 40-67: while browsing a media library opened in response to a first user input a second user input can be employed to add that media item (and metadata incorporated in an ID3 tag) to a playlist by depression of the add button **450).**

Platt does not teach:

A method of **sequentially playing an audio clip from each one of the selected plurality of audio data files**

In a related field of endeavor Heo teaches:

A method and apparatus for reproducing portions of an audio selection or selection comprising **sequentially playing an audio clip from each one of the selected audio data files.** (Col 7, l. 18-57; Figure 8) Highlights or clips from each of a listed plurality of media files are played in sequence until the end of the list is reached.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the sequential highlight or clip playing disclosed by Heo in the Platt method of compiling a playlist and previewing media files. One would have been

motivated to do so for the purpose of aiding in the rapid identification of a track or sequence of tracks in a large media library.

18. Regarding claim 17 – see above rejection of claims 2, 10

19. Regarding claim 18 – see above rejection of claims 3, 11

20. Regarding claim 19 – see above rejection of claims 4, 12

21. Regarding claim 20 – see above rejection of claims 5, 13

22. Claims 6, 7, 9, 14, 16, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platt in view of Heo as applied to claims 1-5, 8, 15 above, and further in view of Eyal et al. (US PGPub 2002/0116476 hereinafter Eyal.)

23. Regarding claim 6

Platt in view of Heo teaches:

The method of claim 1 wherein a user can add or not add an audio file corresponding to a currently playing audio clip to a playlist (see rejection of claim 1 above – a media file can be previewed and optionally added to a playlist through depression of the add button **450** – Platt: Col 6, l. 40-76: Fig 4)

Platt in view of Heo does not teach:

The method of claim 1, **wherein each audio clip continues to be played until the user selects to add or not add the associated audio data file corresponding to the currently playing audio clip to the playlist.**

In a related field of endeavor Eyal teaches:

A method for playing back media files (see Abstract) wherein each audio clip continues to be played until an event occurs which causes the media player to proceed to the next file in the queue for playback (section [0197]; Fig 11.) Eyal teaches that events which cause playback to proceed to the next item in the queue comprising a skip even and an error event but the indicia that the user chose to skip to the next item in the playback queue can also include an add to playlist event inserted at this step. It would have been obvious to one of ordinary skill in the art at the time of the invention to include an add to playlist event signifying that the method should step to the next item in the playback queue as taught by Eyal within the method of Platt in view of Heo. One would have been motivated to do so for the purpose of more rapidly and efficiently searching through local and networked media libraries for music which the end user prefers and wishes to experience again.

24. Regarding claim 7

Platt in view of Heo teaches:

The method of claim 1

Platt in view of Heo does not teach:

The method of claim 1, **further comprising the step of allowing user selection of one of a plurality of playlists to which to include the identifying data.**

In a related field of endeavor Eyal teaches:

A method for playing back media files (see Abstract) which allows a user to select on of a plurality of playlists to which to add a currently media file selection. A playlist feature is a selectable icon **1960** (not shown in figure). Upon selection a pop up window is

displayed which allows the user to name a new playlist or select an extant playlist to which to add the media resource being played. (s. [0267]; Fig 21) It would have been obvious to one of ordinary skill in the art at the time of the invention to include allowing user selection of one of a plurality of playlists to which to include the identifying data as taught by Eyal within the method of Platt in view of Heo.

25. Regarding claim 9

Platt in view of Heo teaches:

The digital audio data player of claim 8

Platt in view of Heo does not teach:

The digital audio data player of claim 8, **wherein the controller allows inclusion of identifying data to a user selectable playlist of digitally encoded audio data files of a plurality of playlists of digitally encoded audio data files.**

In a related field of endeavor Eyal teaches:

A method for playing back media files (see Abstract) wherein the controller allows inclusion of identifying data to a user selectable playlist of digitally encoded audio data files of a plurality of playlists of digitally encoded audio data files. On the controller depicted, a playlist feature is included as a selectable icon **1960** (not shown in figure). Upon selection a pop up window is displayed which allows the user to name a new playlist or select an extant playlist to which to add the media resource being played. (s. [0267]; Fig 21) It would have been obvious to one of ordinary skill in the art at the time of the invention to include allowing user selection of one of a plurality of playlists to

which to include the identifying data as taught by Eyal within the method of Platt in view of Heo.

26. Regarding claim 14 – see above rejection of claim 6: controller as depicted in Platt: Fig 4 functions in a suitable manner

27. Regarding claim 16 – see above rejection of claims 7, 9

28. Regarding claim 21 – see above rejection of claims 6, 14

Response to Arguments

29. Applicant's arguments filed 9/09/08 have been fully considered but they are not persuasive.

Applicant argues:

Neither Platt nor Heo, whether taken individually or in combination, teaches or suggests the subject matter of independent claims 1, 8 and 15. Platt fails to teach [a] method including sequentially playing an audio clip from each one of the selected audio data files," Heo fails to remedy the deficiencies of Platt. In particular, Heo discloses a method and apparatus that allows users to highlight a portion of an audio track as a representative portion of the audio track. These highlighted portions may then be reproduced in a sequence (see, for example, FIG. 4B). Heo fails to teach or suggest, inter alia, that audio data files are sequential played to enable a user to determine which audio data files will be included in a playlist, as claimed. Heo also fails to teach or suggest, inter alia, the steps of "detecting whether a user input is received while each audio clip is being played" or "including identifying data for the digital audio data file associated with

a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played", as recited for example by amended independent claim 1. Accordingly, Heo fails to remedy the deficiencies of Platt. For this reason alone, the instant rejection should be withdrawn.

Applicants further submit that one of ordinary skill in the art would have absolutely no motivation to modify Platt in the manner proposed by the Examiner.

In response please consider:

Examiner agrees that Platt is silent regarding the sequential playing of a plurality of selected audio clips however the interface disclosed by Platt in Figure 4 suggests such. One of ordinary familiarity with a Windows or Macintosh operating system environment would be motivated by Platt's silence to seek a means for using the Platt interface to browse a plurality of media file. A possible instance of such a motivation can be found in the desire of a user of a portable media device to form a list of media files to be copied to his portable device from a large library of files to which the user has limited access.

The Heo method of highlighting audio tracks or portions thereof and reproduce such in sequence comprises one method by which the appropriately motivated browser of a large library of media titles might choose to indicate media file preference and a desire for delivery of such preferred title to said user's portable media device.

Heo does however disclose selection of a plurality of data files and sequential playback of selected or all data files on a recording medium, further should a user forbear to designate specific entry and exit points as representative portions of one or more audio tracks the method instead reproduces an opening portion of the track so that the user can

quickly determine if the track is desired by or otherwise meets the needs of said user (Col, 4, l. 3-46; Col 5, l. 3-10; Col 7, l. 17-25; Fig 8)

Heo and Platt each fail to teach the detection of a user input specifically at the time of media file playback, in a modern multithreaded processor environment One of Ordinary Skill, such as Platt or Heo, can reasonably expect modern computing hardware to operate capably to receive input while simultaneously delivering output.

As demonstrated Platt in view of Heo makes obvious the amended claims. The user interface of Platt: Figure 4 operates in the manner disclosed in claims 8 and 15.)Platt provides a device interface but remains silent regarding selecting and previewing a plurality of media files leading one of ordinary skill in the art to seek clarification on how to best preview an entire album of songs or a plurality of selected media files. Platt combined with Heo provides a system and method for browsing media files on a media library to which a user has intermittent access. A user can select a plurality of files in said library and preview them sequentially by applying the method of Heo shown in at least Heo: Figure 8. A user can thereby quickly create a media list or playlist indicative of preferred files which the user would like delivered to the user's portable media player.

30. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, combination of Platt with Heo flows from a silence on the part of Platt regarding operative characteristics of the media player of Platt: Figure 4. In particular Platt discloses that the media player acts in an expected manner to those familiar with the Windows or Macintosh operating systems. That is, when a file is clicked it is selected and can be operated upon with buttons. When a file is double clicked it is player. Platt is silent on the operation of his media player when a user may want to select a plurality of files for potential inclusion into a playlist. The likely instance of a user browsing a large database of media files to which the user has limited access serves as a suitable example. In such a case the user might want to expediently scroll through a large number of tracks selecting them for a playlist or further copy that can be delivered to the user's media device. Platt envisions methodologies in keeping with the functional components of his device but left indefinite in his disclosure. (Platt: Col 18, l. 24-38) As Platt is silent on such a utility one would be motivated to consider a highlight and reproduction method such as that disclosed by Heo.

Conclusion

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL MCCORD whose telephone number is (571)270-3701. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KUNTZ CURTIS can be reached on (571)272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. M./
Examiner, Art Unit 2614
/CURTIS KUNTZ/

Supervisory Patent Examiner, Art Unit 2614